

REMARKS/ARGUMENTS

The Examiner has delineated the following inventions as being patentably distinct:

Group I: Claims 1-2, 5-9 and 11-12, drawn to a method to produce a modified propylene homopolymer (Claims 1-2 and 5-8), a modified propylene homopolymer (Claim 9), an adhesive composition (Claims 11-12),

Group II: Claims 3-4, 10, 13-14, and 15-18, drawn to a method to produce a modified propylene copolymer (Claims 3-4 and 15-18), a modified propylene copolymer (Claim 10), an adhesive composition (Claims 13-14).

Applicants provisionally elect with traverse the invention of Group I, Claims 1-2, 5-9 and 11-12 drawn to a method for producing a modified homopolymer, a modified propylene homopolymer, an adhesive composition.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required. The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims of the restricted groups are independent or patentably distinct. The restriction is based on a propylene homopolymer of Group I as opposed to a propylene copolymer of Group II. Upon examination one will note that essentially the same process is used for making the copolymer as the homopolymer and both methods must satisfy the same conditions. Products being made by the same method should be examined together especially wherein the sale disclosed utility of the product is the same i.e., is that recited in the specification. The products of Group I and Group II find utility as adhesive composition, and are considered related inventions under 37 C.F.R. §1.475(b) and unity of invention between the groups exist.

Applicants respectfully traverse on the additional grounds that the Office has not shown that a burden exists in searching the entire application.

Further, the M.P.E.P. §803 states as follows:

If a search and examination of an entire application can be made without a serious burden, the Examiners must examine it on its merits even though it includes claims to distinct and independent invention.

Applicants submit that a search of all of the claims would not constitute a serious burden on the Office. In fact, the International Search Authority has searched all the claims together. As the Office has not shown any evidence that restriction requirement should now be required when the International Preliminary Examination Report did not, the restriction is believed to be improper.

37 C.F.R. §1.475(b) provides in relevant part that “a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to products, manufacture of said product and the use thereof”.

For the reasons recited above, Applicants request that the Restriction Requirement be withdrawn.

Further, Applicants reserve the right to file a divisional application on the non-elected subject matter, if so desired, and be accorded the benefit of the filing date of the parent application.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits and an early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Paul J. Killos
Registration No. 58,014

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 03/06)